UNITED STATES PATENT AND TRADEMARK OFFICE

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WITHERS & KEYS FOR BELL SOUTH	ROSE, HELENE ROBERTA	
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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
	10/601,812	MACMILLAN, BRUCE DANIEL
Office Action Summary	Examiner	Art Unit	
	Helene Rose	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *11 January 2007*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-3 and 8-20* is/are pending in the application.

    4a) Of the above claim(s) *4-7* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-3 and 8-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *06/23/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Detailed Action

1. In response to communication entered on 01/05/2007, Claims 1-3 and 8-20 are

presently pending. No claims were amended, cancelled, nor added.

2. Applicants arguments with respect to claims 1-3 and 8-20 have been considered, but

are not persuasive.

Claim Objection

3. In view of the objection to Claim 1 being objected to because of the following

informalities: Claim 1 has a comma vs. a semicolon after "at an e-mail server".

Examiner withdraws the pending the rejection, wherein it was determined to be an error.

Claim Rejections –35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under
section 122(b), by another filed in the United States before the invention by the
applicant for patent or (2) a patent granted on an application for patent by another
filed in the United States before the invention by the applicant for patent, except
that an international application filed under the treaty defined in section 351(a)
shall have the effects for purposes of this subsection of an application filed in the
United States only if the international application designated the United States
and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3,8,15-17 and 20 are rejected under 35 U.S.C. 102(e) as being

anticipated by BRECK (US Publication No. 2003/013063, Filing Date: December

19,2002).

Claim 1:

Regarding claim 1, BRECK teaches a method for accessing information in a

private database, the method comprising:

at an e-mail server (Paragraph [0046], wherein a message system is defined,

Breck),

receiving a request from a wireless communication device to access the

information in the private database (paragraph [0025], wherein the message protocol can

include simple mail transfer protocol, i.e. smtp and/or wireless application protocol, i.e.

wap, and paragraph [0043], wherein a received message can be parsed and/or analyzed

for source information data and such source information can be processed in hierarchical

manner based on the message processing rules to determine whether the message should

be delivered to the individual user, Breck);

upon receiving the request, comparing an email address identified with the

wireless communication device against a list of e-mail addresses residing at the e-mail

server, and if the identified e-mail address is on the list, then authorizing access to the

private database (paragraph [0051], wherein a recipient user can create or otherwise

designate a list of users, domains, and/or networks can be trusted or blocked and so forth,

and paragraph [0056], wherein a system user can establish list of trusted source id's,

source domain, and source networks, and so forth and paragraph [0086], wherein source

network can be compared to a recipient users preferences to determine whether the

recipient user consider the source network to be trusted, and if so determined whether the

recipient user also associates the source id with a block status and so forth, Breck);

sending a query to retrieve the information (paragraph [0085], Breck);

receiving a response to the query, wherein the response includes the information

(paragraph [0047], Breck), wherein the information comprises a list of documents, which

are listed by order of relevance (paragraph [0090], Breck);

sending the information to the wireless communication device (paragraph [0047],

wherein recipient can be associated with a processor controlled device that can be

equipped for receiving messages and such device can be further cable of transmitting

and/or receiving messages via wired and/or wireless communication channels and so

forth, Breck); and

if the identified e-mail address is not on the list, then denying the request to access

the information in the private database (paragraph [0056] and [0051], Breck).

Claim 2:

Regarding claim 2, BRECK teaches wherein receiving the request includes

receiving an e-mail from the wireless communication device (refer to claim 1, wherein

this limitation is substantially the same or similar to the limitation defined within claim 1,

Breck).

Claim 3:

Regarding Claim 3, BRECK teaches wherein receiving the email from the

wireless communication device includes receiving the email from one of a wireless

telephone, a wireless pager and a wireless personal digital assistant (paragraph [0100],

Breck).

Claim 8:

Regarding claim 8, BRECK teaches wherein sending the query includes

identifying text in the e-mail (paragraph [0010], Breck).

Claim 15:

Regarding claim 15, BRECK teaches wherein sending the information to the

wireless communication device includes sending an e-mail to the wireless

communication device (refer to claim 1, wherein this limitation is substantially the same

or similar to the limitation defined within claim 1, Breck).

Claim 16:

Claim 16, which states: a method further comprising: at the e-mail server,

receiving a second request from the wireless communication device, wherein the second

request is for accessing additional information; sending a second query, wherein the

second query is for retrieving the additional information; receiving a response to the

second query, wherein the response to the second query includes the additional

information; and sending the additional information to the wireless communication.

Claim 16, have similar limitations to Claim 1, Therefore, Claim 16 is rejected

under the same rational as Claim 1, BRECK.

Claim 17:

Regarding claim 17, BRECK teaches an apparatus for accessing information in a

private database, the apparatus comprising:

an e-mail server for accessing the private database wherein the e-mail server is

configured for communication with a wireless communication device (REFER to claim 1,

wherein this limitation is the same/similar limitation to claim 1, in which this limitation is

rejected under the same rational as claim 1) and includes:

an identification module for identifying an e-mail address of the wireless

communication device (Figure 9a, wherein email address are illustrated, Breck); and

an authorization module for authorizing the e-mail server to access the private

database and forward the information to the wireless communication device (paragraph

[0051], wherein forward message is defined, and wherein domains or networks can be

trusted or block, Breck), wherein the authorization module is operative to compare the e-

mail addresses identified with the wireless communication device against a list of e-mail

addresses residing at the e-mail server, and if the identified e-mail address is on the list,

then authorizing access to the private database, and if the identified e-mail address is not

on the list, then denying the request to access the information in the private database,

wherein the information comprises a list of documents which are listed by order of

relevance (paragraph [0052], [0080] and [0088], Breck).

Claim 20:

Regarding claim 20, BRECK teaches a computer-readable medium having stored

thereon a set of instructions which, when executed by a processor, cause the processor to:

identify an e-mail address of a wireless communication device (Figure 9a,

wherein email address are illustrated, Breck); and

authorize an e-mail server to access information in a private database and forward

the information to the wireless communication device (REFER to claim 19, wherein this

limitation is the same/similar limitation to claim 19, in which this limitation is rejected

under the same rational as claim 19), wherein the processor (paragraph [0051], wherein

the message processing rules can be a set of instructions, Breck), in authorizing an e-mail

server to access information in the private database is operative to compare the e-mail

address identified with the wireless communication device against a list of e-mail

addresses residing at the e-mail server, and if the identified e-mail address is on the list,

then authorizing access to the private database, and if the identified e-mail address is not

on the list, then denying the request to access the information in the private database,

wherein the information comprises a list of documents which are listed by order of

relevance (REFER to claim 19, wherein this limitation is the same/similar limitation to

claim 19, in which this limitation is rejected under the same rational as claim 19, Breck).

Claim Rejections 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made to
> a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

7.   Claims 9-14 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over BIRRELL et al (Birrell hereinafter, US Patent No. 6,185,551, Date of Patent: Feb. 6,

2001) as applied to claims 9-14, in view of PURCELL (US Patent No. 5,940,807, Date of

Patent: August 17, 1999) as applied to claims 18 and 19.

Claim 9:

Regarding claim 9, BIRRELL teaches wherein identifying text in the e-mail

includes identifying a word associated with the information (Column 7, Lines 23-30,

Birrell).

Claim 10:

Regarding claim 10, BIRRELL teaches wherein identifying the word in the e-mail

includes identifying an acronym associated with the information (column 7, lines 39-45,

wherein EOM is defined and Figure 5, diagram 530 and diagram 550, Birrell).

Claim 11:

Regarding claim 11, BIRRELL teaches wherein identifying text in the e-mail

includes identifying a phrase associated with the information (Column 5, Lines 51-57,

Birrell)

Claims 12 and 13:

Regarding claims 12 and 13, BIRRELL teaches wherein identifying text in the e-

mail includes identifying a letter (Column 13, Lines 10-11, Birrell)

Claim 14:

Regarding claim 14, BIRRELL teaches wherein receiving the response includes

receiving the information (Column 3, Lines 34-41, Birrell).

Claim 18:

Regarding claim 18, BIRRELL discloses all the claimed subject matter as stated

above. However, BIRRELL does not disclose wherein e-mail server comprises a portion

of an Intranet. On the other hand, PURCELL discloses wherein e-mail server comprises

a portion of an Intranet (column 8, lines 32-39, wherein an intranet is an in house

application, such as an organization, Purcell). It would have been obvious to one of the

ordinary skill in the art at the time of the invention was made to modify Birrell system in

view of Purcell to provide an e-mail server that comprises a portion of an Intranet. A

skilled artisan would have been motivated to do so by including Intranet for internal use

to facilitate communication and access to information within an organizational

environment; providing restricted access, wherein it monitors the traffic flow;

authorization for accessing information; blocking probhibited information from viewing,

as well as tracking a users activity.

Claim 19:

Regarding claim 19, BIRRELL in view of PURCELL discloses wherein the e-

mail server comprises a portion of an Extranet (column 4, lines 40-50, wherein a private

network that uses the Internet protocols, Purcell).

Examiner Response to Applicant Arguments

(8)   Applicant Argues:

Applicant argues prior art fails to teach, "receiving a request to access information in a

private database".

Examiner Response:

Examiner is not persuaded. Referring to paragraph [0043], wherein processing rules can

be generated by authorized individuals associated with the recipient user account,

recipient domain, and/or recipient network, wherein the system can allow or otherwise

provide for a hierarchical set of message processing rules or filters, where a received

message can be parsed and/or analyzed for source information data and such source

information can be processing rules to determine whether the message should be

delivered to the individual user, wherein once again the "processing rules" as stated

above can be generated by authorized individuals, and wherein it determines whether a

message should be delivered to a user or detained for review by the user, wherein this is

interpreted to be equivalent to "receiving a request to access information in a private

database"; and

Also see paragraph [0064], wherein an authentication means can be provided via a user

interface such as the user interface that can request a login name and password from the

system user, which is also equivalent to "receiving a request to access information in a

private database", wherein login name and password is needed for access, and when the

system receives a message that includes a message attribute or other data indicating that

the sender/source is from within the system, and the system can determine whether the

message source is associated with an acceptable domain and/or network for the purported

system user who is the sender/source, and/or perform another type of authorization and/or

validation that can indicate whether the source who is purportedly a system user, is

actually the system user and wherein digital certificates can be used for authentication.

(9)   Applicant Argues:

Applicant argues prior art fails to teach, "sending a query to retrieve information in the

private database".

Examiner Response:

Examiner is not persuaded. Referring to paragraph [0091], wherein the method and

system may validate that the system user sending the message is authorized to send the

message and can validate the identity of the system user, wherein outgoing messages can

be queued by the system for processing, wherein the user validation for outgoing

messages can be performed before or after hierarchical processing, wherein the

hierarchical processing of outgoing and/or incoming messages may not be performed,

wherein outgoing messages processing can include custom checks, wherein a system user

may have system preferences that may be different for incoming messages and outgoing

messages, wherein message attributes for outgoing messages can also include source id,

source domain and source network, which is interpreted to be equivalent to "sending a

query to retrieve information in the private database".

Also see paragraph [0085], wherein the processing may query whether the domain

administrator associates the source network with a block status, and if the domain

administrator neither associates the source network with a trusted nor block status, the

process may continue by processing the source network at a third hierarchical level, or at

the recipient user level and wherein if the domain administrator associates the source

network at a block status, may allow the recipient user source ID preferences to

determine the message processing, wherein a recipient user's preferences can determine

message processing, which is also interpreted to be equivalent to "sending a query to

retrieve information in the private database".

(10) Applicant Argues:

Applicant argues prior fails to teach, "receiving a response to the query wherein the

responses includes the information, wherein the information comprises a list of

documents which are listed by order of relevance".

Examiner Response:

Examiner is not persuaded. Referring to Figure 10, diagram 54, wherein view domains

with queued mail, which is interpreted to be equivalent to information; paragraph [0050],

wherein for incoming messages, a message processing rule provided by a System

Administrator can be understood to have processing order priority relative to message

processing rules provided by a Domain Administrator and a Recipient user, and similarly,

a message processing rule provided by a Domain Administrator can have processing

order priority relative to processing rules provided by a Recipient user, wherein

references herein to order priority can be understood to indicate, wherein this is

interpreted to be equivalent to "order of relevance", wherein for example, that a

processing rule, e.g., designation of a user as trusted or blocked, provided by a System

Administrator can be considered prior to a processing rule provided by a Domain

Administrator and/or a Recipient user, although as provided herein, wherein the systems

and methods can allow a Recipient user, e.g., comparatively lower level processing level,

to provide a processing rule that can selectively override, negate, or otherwise direct

message processing regardless of a System Administrator processing rule, wherein

"hierarchical levels" is interpreted to be a form of a document or files structure, known as

a tree structure, which is equivalent to "a document"; and paragraph [0074], wherein

provides one report that includes statistics and other data such as detained message data

(e.g., detained messages, statistics), stealth event data, and other data and wherein figures

9a and 9b illustrate a report related to stealthed messages, and an exemplary list of trusted

addresses, which is interpreted to be equivalent to "a list of documents".

(11)   Applicant Argues:

Applicant argues the prior art of record (BRECK) fails to disclose each and every

element recited in independent claim 1.

Examiner Response:

Examiner is not persuaded. Referring to claim 1, wherein it cites "upon receiving the

request, comparing an e-mail address identified with the wireless communication device

against a list of e-mail addresses residing at the e-mails server and if the identified e-mail

address is on the list, then authorizing access to the private database", SEE paragraph

[0051], wherein a recipient user can create or otherwise designate a list of users, domains,

and/or networks can be trusted or blocked and so forth; paragraph [0056], wherein a

system user can establish list of trusted source id's, source domain, and source networks,

and so forth; and paragraph [0086], wherein source network can be compared to a

recipient users preferences to determine whether the recipient user consider the source

network to be trusted, and if so determined whether the recipient user also associates the

source id with a block status and so forth, which is equivalent to "upon receiving the

request, comparing an e-mail address identified with the wireless communication device

against a list of e-mail addresses residing at the e-mails server and if the identified e-mail

address is on the list, then authorizing access to the private database".

and referring to the limitation "sending the information to the wireless device", SEE

paragraph [0047], wherein recipient can be associated with a processor controlled device

that can be equipped for receiving messages and such device can be further cable of

transmitting and/or receiving messages via wired and/or wireless communication

channels and so forth, which is equivalent to "sending the information to the wireless

device";

and "if the identified e-mail address is not on the list, then denying the request to

access the information in the private database", SEE paragraph [0019], wherein the

processing rules can include associations of message attributes with at least one of a

trusted state and a blocked state; and paragraph [0051], wherein a designation of

"blocked" can indicate that a Recipient user does not wish to receive messages from the

associated message source/sender, wherein a recipient user can further associate other

message processing rules and/or actions with blocked messages, such that blocked

messages can be processed based on at least one of an accept/relay module, an so forth,

wherein block messages can be based on an accept/relay module, which is interpreted to

be "accepting or denying a request", which is interpreted to be equivalent to "denying

the request to access the information in the private database".

Examiner Notes that the remaining limitations cited within claim 1, has already

been addressed. See above (No. 8-10)

(11)   <u>Applicant Argues:</u>

Applicant argues that there is no motivation to combine Birrell in view of Purcell, since

there both references teach away from the claim recitations, and there would be no

likelihood to combine Birrell in view of Purcell.

<u>Examiner Response:</u>

Although, Applicant suggest there is no suggestion to combine the references discrete

elements of the <u>Birrell et al</u> and <u>Purcell</u> references, the arguments have been fully

considered but are not found to be persuasive. **The examiner recognizes that**

obviousness can only be established by combining or modifying the teachings of the

prior art to produce the claimed invention where there is some teaching, suggestion,

or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

Cir. 1992).

In response to applicant's argument, Birrell et al (US Patent No. 6,185,551) and Purcell

(US Patent No. 5,940,807) is nonanalogous art, it has been held that a prior art reference

must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent

to the particular problem with which the applicant was concerned, in order to be relied

upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443,

24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Although Birrel et al, teaches an electronic mail messaging. The secondary

reference, Purcell teaches a method for improving information exchange between parties.

As previously stated above, a person having ordinary skill in the art at the time the

invention was made would be motivated to modify the invention of Birrell et al by the

teaching of Purcell (column 8, lines 32-39) to for the purpose of implementing an

extranet for internal use to facilitate communication and access to information within an

organizational environment as well as to restrict and allow access based on authorization

of an user.

Conclusion

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

13.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the mailing date of this final action.

Prior Art of Record

(The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure)

1. Gromelski et al (US Patent No. 6,377,161) discloses a first portable messaging unit

(PMU) sends address information to a second PMU through a wireless messaging

system, wherein the second PMU receives address information. In response to the

receive address, the second PMU verifies whether or not the information is identical to

the address information and then stores it in a address book and then processes the

address information in a predetermined manner which is dependent upon the result of the

check.

2. Goedken (US. Patent No. 6,393,423) discloses methods and apparatus for facilitating

information exchange between an information requestor and one or more information

custodians via a network.

3. Purcell (US Patent No. 5,940, 807) discloses a method for controlling a collection,

processing and dissemination of information by a host regarding product and service

availability. The method includes establishing a host operated information management

system wherein the information management system is a computer having information

processing and storage capabilities.

4. <u>Breck</u> (US Publication No. 2003/0131063) discloses a method and system for

processing a message.

5. <u>Birrell</u> (US Patent No. 6,185,551) discloses a computerized distributed mail system, a

plurality of client computers are connected to each other via a network for accessing the

mail messages by the plurality of computers by searching full text index using queries.
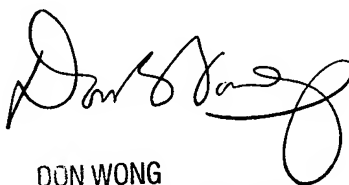
Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene R. Rose whose telephone number is (571) 272-0749. The examiner can normally be reached on 8:00am - 4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HRR
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March 7, 2007

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